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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,041	03/26/2004	Kazuya Matsumoto	17575	9537

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EXAMINER

SMITH, PHILIP ROBERT

ART UNIT	PAPER NUMBER
3739	

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/811,041	Applicant(s) MATSUMOTO ET AL.	
	Examiner Philip R. Smith	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/26 & 7/15/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

[01] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[02] Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda (5,681,260) in view of Biglieri (6,958,577).

[03] With regard to claim 1: Ueda discloses a capsule endoscope system comprising:

[03a] a capsule endoscope ("capsule type endoscope 150," 18/8), of which movement is controlled by a magnetic field externally applied (via "guided part 159," 18/50);

[03b] at least one magnetic-field generating means ("magnetic force generating part 31," 18/45) for generating a magnetic field focused on one point to control the movement of the capsule endoscope traveling in a body cavity of a subject lying down on an examination table ("bed 10," 8/42-50); and

[03c] moving means for moving ("magnetic force generating apparatus 11," 8/51-65) the magnetic-field generating means relative to the examination table.

[04] Ueda does not disclose moving means for moving the examination table relative to the magnetic-field generating means.

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[05] Biglieri discloses the following in 5/23-30:

According to a further embodiment of FIG. 6, a magnetic structure may be provided which is displaced relative to the patient table, hence to the body under examination or the part thereof to a predetermined extent and in predetermined directions.

In this case, the magnetic structure 1 or the patient table 2, or both may be displaced relative to each other.

[06] Biglieri demonstrates the equivalence of the claimed invention with the invention disclosed by Ueda. At the time of the invention, it would have been obvious to a person of ordinary skill in the art that the examination table disclosed by Ueda could be moved relative to the magnetic-field generating means disclosed by Ueda, as opposed to the other way around. A skilled artisan may turn to this obvious and equivalent alternative if, for example, the magnets (due to their weight) are more difficult to move than the patient; or if the wires associated with an electromagnetic field-generating device are short or cumbersome.

[07] With regard to claim 2: Ueda discloses that a magnetic-field generating member ("guided part 159," 18/50) is arranged in at least one portion of the capsule endoscope.

[08] With regard to claim 3: Ueda discloses that the magnetic-field generating member includes a magnetic material ("made of a permanent magnet," 18/25-26).

[09] With regard to claims 4-5: Ueda discloses that the magnetic-field generating member includes a magnetic material, which must be either hard or soft. Where there is a limited universe of well-known alternatives, it is obvious to a skilled artisan that either may be used.

- [10] With regard to claim 6: Ueda discloses that the magnetic-field generating member may include a magnetic coil arranged in the interior of the capsule endoscope ("formed of a coreless coil instead of a permanent magnet," 23/6-9).
- [11] With regard to claim 7: Ueda discloses that a plurality of magnetic coils ("three coreless coils 281, 282 and 283," 22/25-26) may be arranged in the capsule endoscope, and a current selectively supplied to at least one of the magnetic coils in a time series manner.
- [12] With regard to claim 8: Ueda discloses that the magnetic-field generating means electrically generates a magnetic field such that the magnetic field is controllable (9/14-41).
- [13] With regard to claim 9: The magnetic-field generating means disclosed by Ueda is inherently capable of applying a magnetic field intermittently.
- [14] With regard to claim 10: Ueda discloses that the magnetic field generated by the magnetic-field generating means includes an alternating magnetic field (35/1-4).
- [15] With regard to claims 11-13: Ueda discloses that the magnetic-field generating means may be arranged on both sides of the subject to apply magnetic fields to the subject from both the sides in any arrangement so as to surround the subject, including from above and below.
- [16] With regard to claim 14: The magnetic field generated by the magnetic-field generating means disclosed by Ueda is inherently capable of being interrupted.
- [17] With regard to claims 15-16: Ueda in view of Biglieri discloses that the moving

means moves the examination table relative to the magnetic-field generating means to guide the capsule endoscope through the body. The combination is capable of guiding the capsule endoscope from the anus of the subject to an object region to be observed and back (11/9-15).

- [18] With regard to claim 17: Ueda discloses a display device for displaying the position of the capsule endoscope ("TV monitor 7," 7/36).

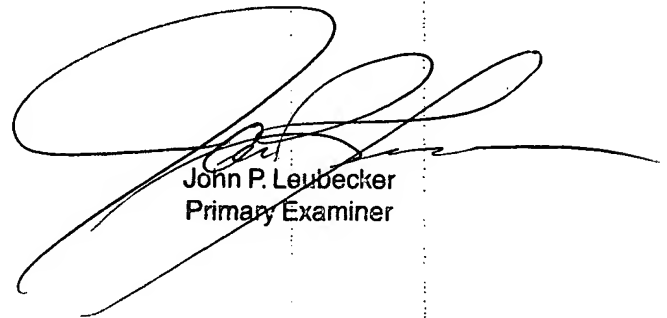
Conclusion

- [19] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Polzin (6,707,300) further demonstrates the equivalence of table movement versus magnet movement in a surgical procedure.
- [20] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip R. Smith whose telephone number is (571) 272 6087 and whose email address is philip.smith@uspto.gov. The examiner can normally be reached between 9:00am and 5:00pm.
- [21] If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272 4764.
- [22] Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

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Should you have questions on access to the Private PAIR system, contact the
Electronic Business Center (EBC) at 866-217-9197 (toll-free).

[23] prs



John P. Leubecker
Primary Examiner